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09/669,854	09/27/2000	Ikuyo Ikeda	196466US 2	6529

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EXAMINER

TRAN, QUOC A

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/669,854

Applicant(s)

IKEDA, IKUYO

Examiner

Quoc A. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: original application filed 07/27/2000.
2. Claims 1-14 are currently pending in this application. Claims 1, 5, 9 and 13 are independent claims.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Oath/Declaration***

4. The oath is objected to as being informal. It lacks authentication by a diplomatic or consular officer of the United States; 37 CFR 1.66(a). This informality can be overcome either by forwarding the original oath to the appropriate officer for authentication or by filing either a declaration under 37 CFR 1.68, or a new properly authenticated oath under 37 CFR 1.66. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. If, however, authentication of the original oath is desired, applicant should request return of the oath for this purpose.

Such request must be accompanied by an order for a copy of the oath to be retained in the file until the properly authenticated oath is returned. After the oath has been authenticated, it should be returned promptly to the Patent and Trademark Office. See MPEP §§ 602.01 and 602.02.

It does not include the notary's signature, or the notary's signature.

It does not include the notary's seal and venue.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen et al. (hereinafter Cullen) (US 5,732,230 – filed 05-1995), in view of Kim (hereinafter Kim) (US 6,081,341 – filed 05-1998).**

6. As to **independent claim 1**, Cullen discloses:

inserting device configured to insert a note into an image of an original document  
(add ***more image fragments to an existing integrated image***, see Cullen col. 7, lines

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61-62), produced on a computer (***The reproduced image can be displayed on a display screen for further manipulation by a human operator***, see Cullen col. 8, lines 14-15) and to be printed (***using the printing device to output the combined image***, see Cullen col. 11, line 54);

a spacing device configured to form a space in an image of the original document in which said note is to be inserted (***performing drag, drop and merge operations on the image fragments. Embodiments of the invention include the use of a touch screen or mouse to allow the user to perform the operations***, see Cullen Abstract);

indicating device configured to display a formed image on a screen of a display device as a preview (***allow a human user to drag, drop and merge, or otherwise manipulate, image fragments ... The reproduced image can be displayed on a display screen for further manipulation by a human operator***, see Cullen col. 7, lines 4-16);

**Cullen does not explicitly disclose** a printing image forming apparatus;

**however Kim teaches** (***an image forming unit utilizing ... printing/scanning operations***, see Kim col. 5, lines 15-22).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate Kim' teaching for presenting the print/scan image forming unit to Cullen's system for manipulating image fragments. One of the ordinary skill in the art would have been motivated to combine these functionality, so that the

user can (***including an image forming unit, transporting an original document***, see Kim col. 5, lines 14-15).

7. As to **dependent claim 2**, Cullen and Kim disclose the limitation as cited in independent claim 1 above and further comprise, wherein said note includes at least one of text (***text to be readable***, see Cullen col. 5, line 55), images (***image on the image***, see Cullen col. 5, line 54) and graphics (***schematics, blueprints or drawings***, see Cullen col. 6, line 41).

8. As to **dependent claim 3**, Cullen and Kim disclose the limitation as cited in independent claim 1 above and further comprise,

spacing device reduces the image of the original document to be printed (***the information printed on each page is also displayed on the reduced page***, see Cullen col. 5, lines 34-35),

and moves said reduced image in up-and-down and right-and-left directions on the screen so as to form the space for inserting said note (***using the mouse to move the pointer on the screen so that the selected fragment is dragged along with the pointer ... so that the user may arrange image fragments freely on the screen. The purpose of the fragment manipulation is to allow the user to easily put the image fragments together on the screen and build the original oversize image out of the image fragments***, see Cullen col. 6, lines 18-29).

9. As to **dependent claim 4**, Cullen and Kim disclose the limitation as cited in independent claim 1 above and further comprise, the displayed formed image includes a combined image of the original document and said inserted note, and said combined

image (***mechanism for merging, or compositing, a first image onto a second image***, see Cullen col. 2, lines 10-12) is edited by a drag and drop operation on said preview (***"drag"... "dropped"***, see Cullen col. 6, lines 14-22).

10. As to **independent claim 5**, Cullen discloses a computer readable printer driver program performing the steps of:

producing on a computer an original document to be printed (***images to be "captured" by computer systems by, e.g., scanning a printed version of an image***, see Cullen col. 1, lines 20-23);

displaying the original document on a screen of a display device (***obtain a digital representation of the image***, see Cullen col. 1, lines 21-22);

preparing a note to be inserted into the image of the original document (***input two or more image fragments of an original image***, see Cullen col. 2, line 58);

reducing the image of the original document to be printed (***the information printed on each page is also displayed on the reduced page***, see Cullen col. 5, lines 34-35);

moving said reduced image in up-and-down and right-and-left directions on the screen so as to form a space for inserting said note (***various tools to aid in accurate alignment, positioning and merging of the image fragments to produce an integrated image***, see Cullen col.7. lines 9-11);

inserting said note into said formed space; displaying a combined image on the screen of the display device as a preview; and performing a drag and drop operation of said combined image on said preview (***performing drag, drop and merge operations***

**on the image fragments. Embodiments of the invention includ the use of a touch screen or mouse to allow the user to perform the operations**, see Cullen Abstract);

**Cullen does not explicitly disclose** a recording medium recorded ....

**however Kim teaches (apparatus to record image data onto a recordable medium**, see Kim Abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate Kim' teaching for recording image data onto a recordable medium with Cullen computer readable print driver. One of the ordinary skill in the art would have been motivated to combine these functionality, so that the user can enabling **(a user interface for manipulating images and specifically to a computer user interface for combining image fragments**, see Cullen col. 1, lines 16-17), then **(record image data onto a recordable medium**, see Kim Abstract).

11. As to **dependent claim 6**, Cullen and Kim disclose the limitation as cited in independent claim 5 above and further include the same limitations as claim 2, and are similarly rejected under the same rationale.

12. As to **dependent claim 7**, Cullen and Kim disclose the limitation as cited in independent claim 5 above and further included a print controlling apparatus **(input/output (I/O) controller, an external device such as a printer**, see Cullen col.3, line 58).

13. As to **dependent claim 8**, Cullen and Kim disclose the limitation as cited in independent claim 7 above and further included an image processing system **(image forming unit enabling the apparatus to record image data onto a recordabl**



**medium**, see Cullen Abstract) and a printer (***an external device such as a printer***, see Cullen col. 3, lines 58-59).

14. As to **independent claim 9**, includes the same limitation as independent claim 1, and are similarly rejected under the same rationale.

15. As to **dependent claim 10**, Cullen and Kim disclose the limitation as cited in independent claim 9 above and further include the same limitations as claim 2, and are similarly rejected under the same rationale.

16. As to **dependent claim 11**, Cullen and Kim disclose the limitation as cited in independent claim 9 above and further include the same limitations as claim 3, and are similarly rejected under the same rationale.

17. As to **dependent claim 12**, Cullen and Kim disclose the limitation as cited in independent claim 9 above and further include the same limitations as claim 4, and are similarly rejected under the same rationale.

18. As to **independent claim 13** is directed to method for forming a printing image, implementing the a computer-readable storage medium storing computer program product of independent claim 5 which cited above, and are similarly rejected under the same rationale.

19. As to **dependent claim 14**, Cullen and Kim disclose the limitation as cited in independent claim 13 above and further include the same limitations as claim 2, and are similarly rejected under the same rationale.

### ***Conclusion***

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20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barrett	U.S. Patent No. 5,260,805	issued	11-1993
Levine et al.	U.S. Patent No. 6,167,439	issued	12-2000
Koh et al.	U.S. Patent No. 6,173,088 B1	issued	01-2001

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
JOSEPH H. FEILD  
PRIMARY EXAMINER